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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/005,023
Filing Date: December 04, 2001
Appellant(s): STIEBER ET AL.

Michael J. McGovern
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 3/29/2006 appealing from the Office action mailed 11/2/2005.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

No evidence is relied upon by the examiner in the rejection of the claims under appeal.

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections - 35 USC § 112

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 20 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

There is no indication in the specification that the newly added limitation in which “the system control unit performs at least one of the operations of cash dispensing, providing for cash settlement and monitoring maintenance information without needing authorization of user access from a remotely located network host computer” is taught by the applicant. In fact, the applicant’s newly added limitation teaches away from the specification. In paragraph [0029] of the applicant’s specification, it states that “security features, including authentication and encryption algorithms, can be used to secure communications between devices” which contradicts the newly added limitation.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

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A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1-22 are rejected under 35 U.S.C. 102(e) as being anticipated by Waller et al. (US 2001/0051922).

Referring to Claim 1, Waller teaches a networked cash management system, characterized by:

At least one cash handling device in the system for performing at least one of the operations of coin sorting, coin counting, note counting, note sorting and cash redemption (see paragraph [0057] where it is inherent that an ATM machine performs at least one of the above functions);

A system control unit 24 and 26 (fig. 1) and 24 (fig. 5) for performing at least one of a plurality of operations of accounting for cash dispensing by the cash handling device (see paragraph [0021]), providing for cash settlement of transactions carried out by the cash handling device, and monitoring maintenance information (see paragraph [0009]), said control unit also providing commands to the cash handling device for operation of the cash handling device (see paragraphs [0011] and [0014]);

wherein said cash handling device and said system control unit communicate through a wireless communication network operating according to a standard for locally distributed wireless networks (see paragraph [0011] noting “local wireless technology”); and

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wherein the locally distributed wireless network communicates directly without intermediate servers and within a range between the cash handling device and the control unit of no more than approximately 100 meters (see paragraph [0011]).

Referring to Claim 13, Waller teaches a wireless networked cash management system comprising:

A system control unit including a radio frequency transceiver 24 and 26 (fig. 1) and 24 (fig. 5); and

A cash handling device, the cash handling device including a radio frequency transceiver for communicating cash handling data and status data to the control unit (see paragraphs [0011] and [0014]);

wherein the transceivers communicate directly with each other without the assistance of servers and wherein the transceivers communicate within a range of no more than approximately 100 meters (see paragraph [0011]); and

wherein the system control unit performs at least one of the operations of accounting for cash dispensing by the cash handling device (see paragraph [0021]), providing for cash settlement of transactions carried out by the cash handling device and monitoring maintenance information (see paragraphs [0011] and [0014]).

Referring to Claims 2, 16 and 19, Waller also teaches a coin handling device for performing at least one of the operations of coin sorting and totalizing, coin counting and cash redemption (see paragraph [0021]).

Referring to Claim 3, Waller teaches a currency handling device for performing at least one of the operations of note sorting, note counting and cash redemption, wherein

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said currency handling device and said control unit communicate through the wireless communication network (see paragraph [0021]).

Referring to Claim 4, Waller also teaches the cash handling device as a currency handling device for performing at least one of the operations of note sorting and totalizing, note counting and cash redemption (see paragraph [0021]).

Referring to Claim 5, Waller also teaches at least one I/O device, wherein the I/O device is a cell phone or a personal digital assistant (see paragraph [0009]).

Referring to Claim 6, Waller also teaches the system control unit electrically connected to a second network selected from a group consisting of: the Internet, an intranet, a LAN and a WAN (see paragraph [0067]).

Referring to Claim 7, Waller also teaches the second network utilizing at least one of a telephone dial-up modem, a digital satellite link modem and a broadband cable modem (see paragraph [0073]).

Referring to Claim 8, Waller also teaches operation according to the Bluetooth specification (see paragraph [0011]).

Referring to Claim 9, Waller also teaches operation according to the RS-232 protocol (see paragraph [0070]).

Referring to Claim 10, Waller also teaches operation in a frequency hopping, spread spectrum range of frequencies in a range from 2.4 GHz to 2.56 GHz (see paragraph [0011]).

Referring to Claim 12, Waller also teaches operation in a piconet distinguished from other networks by a selected frequency hopping sequence (see paragraph [0009]).

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Referring to Claim 14, Waller also teaches a Bluetooth radio (see paragraph [0009]).

Referring to Claims 11 and 15, Waller also teaches operation in the infrared frequency range according to the IrDA standard (see paragraph [0011]).

Referring to Claim 17, Waller also teaches the system control unit comprising a personal computer that performs at least one of the operations of accounting for cash dispensing, providing for cash settlement and monitoring maintenance information for a plurality of cash handling machines (see paragraph [0021]).

Referring to Claim 18, Waller also teaches a computer peripheral I/O device which is at least one of a printer or a visual display (see paragraph [0009]).

Referring to Claim 20, Waller also teaches the system control unit performing at least one of the operations of cash dispensing (see paragraph [0021]), providing for cash settlement and monitoring maintenance information without needing authorization of user access from a remotely located network host computer (see paragraphs [0011] and [0014] noting that the operation of monitoring maintenance information does not need the authorization of a remotely located device).

Referring to Claim 21, Waller also teaches the system control unit performing both of the operations of providing for cash settlement (see paragraph [0021]) and monitoring maintenance information (see paragraphs [0011] and [0014]).

Referring to Claim 22, Waller also teaches at least one I/O device, wherein the I/O device is a cell phone or a personal digital assistant (see paragraph [0009]).

(10) Response to Argument

Appellant's arguments with respect to Claims 1-22 have been fully considered but they are not persuasive.

(A) Regarding independent claims 1 and 13, the appellant argued that the examiner incorrectly used the Waller reference to read on the term "system control unit" by stating that the system control unit in the Waller reference is the host computer (12, fig. 1 of Waller reference).

In response to (A), the examiner reiterates that the PDA and/or cell phone in the Waller reference (24 and 26, fig. 1), was interpreted as the "system control unit" and not the host computer. Firstly, the appellant stated that "There is every indication in the present specification that the system control unit is not a PDA or cell phone. The examiner's response to that statement is that there is no indication in the **claims** that the system control unit is not a PDA or cell phone. There is no indication in the claims what so ever that states that the examiner can not use the handheld devices 24 and 26 (fig. 1) as the system control unit.

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

It is believed that there is no reason to believe that the "system" can not be what is shown in fig. 1 of the Waller reference, mainly because the term "system" was not specifically defined to say otherwise in the **claims**. The device in fig. 1 of the Waller

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reference, according to the definition of the term "system" to one skilled in the art, is indeed a system. Therefore, the examiner maintains his interpretation of the system control unit as the handheld devices 24 and 26 (fig. 1) in the Waller reference. Even if the examiner were to refer back to the specification, the examiner reiterates that the "the system control unit preferably comprises a computer, such as a personal computer, workstation, or other computing device", as shown in paragraph [0016] of the specification. A computing device, by definition to one skilled in the art, can include a wide variety of devices which definitely include the handheld devices 24 and 26 (fig. 1) of the Waller reference. Therefore, when the examiner refers to the handheld PDA of the Waller reference as the system control unit, and not the host computer, it is clearly believed that the Waller reference teaches the other limitations of claims 1 and 13, such as:

A system control unit 24 and 26 (fig. 1) and 24 (fig. 5) for performing at least one of a plurality of operations of accounting for cash dispensing by the cash handling device (see paragraph [0021]), providing for cash settlement of transactions carried out by the cash handling device, and monitoring maintenance information (see paragraph [0009]), said control unit also providing commands to the cash handling device for operation of the cash handling device (see paragraphs [0011] and [0014]); and

wherein the locally distributed wireless network communicates directly without intermediate servers and within a range between the cash handling device and the control unit of no more than approximately 100 meters (see paragraph [0011]).

The same above arguments apply for claim 17.

The arguments against claims 1 and 13, in reference to an I/O device and coupling the control unit to an external network are considered moot by the examiner because none of these limitations are in claims 1 or 13.

(B) The appellant argues that the Waller reference does not teach the limitations of the system control unit “accounting for the cash **dispensing** of the ATM machine” and “monitoring maintenance information”.

In response to (B), Firstly, the function of “the ATM **dispensing** an amount of cash” in the Waller reference is believed to be similar, almost verbatim, to the function of “accounting for the cash **dispensing** of the ATM machine” in the claimed invention. Once again, there is no indication in the **claims** that the lack of software, lack of security, or the lack of desire to give function to retail customers would discount the use of a PDA to account for cash dispensing of an ATM machine, especially when the Waller reference clearly teaches such a function. The same argument applies to the limitation of “monitoring maintenance information”.

(C) Regarding Claims 5 and 22, The appellant argues that the Waller reference does not teach an I/O device.

In response to (C), “further comprising” does not necessarily mean that there must be a second, separate I/O device. Even if the above were true, the examiner need only refer to paragraph [0058] of the Waller reference to show that there are two

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separate handheld devices 24 and 26, both of which are I/O devices (PDA and GSM cellular telephone).

(D) Regarding claims 6 and 7, the appellant argues that the Waller reference does not teach system control unit electrically connected to a second network selected from a group consisting of: the Internet, an intranet, a LAN and a WAN.

In response to (D), there is nothing in the claims that separate "back end" from "front end". Also, there is no indication in the claims that state that two different ports or communication paths are needed. The cited paragraph [0067] states that the cell phone can connect to the Internet, as well as the ATM within close range when referring back to paragraph [0011].

(E) Regarding Claims 10 and 12, the appellant argues that the Waller reference does not teach operation in a frequency hopping, spread spectrum range of frequencies in a range from 2.4 GHz to 2.56 GHz and operation in a piconet distinguished from other networks by a selected frequency hopping sequence.

In response to (E), regarding claim 10, it can be shown that the cell phone in the Waller reference is not just a long range cell phone network by referring to paragraphs [0011] and [0058]. The combination of these two paragraphs show that the cell phone can clearly be the system control unit that communicates within a short range (including less than 100 meters) with the ATM device.

Regarding claim 12, the limitation of "a piconet with possibly one master and

seven slaves” is not included in the claim. In addition, both the limitations in claims 10 and 12 are inherently related to the general definition of the Bluetooth standard, which is clearly taught in the Waller reference (second line of paragraph [0011]).

(F) Regarding claim 14, the appellant argues that the Waller reference does not teach a Bluetooth radio.

In response to (F), the PDA in Waller can operate in both the IrDa and Bluetooth technology as clearly shown in paragraph [0011] (most notably the second and third line of the paragraph). The appellant’s assumption here is incorrect.

(G) Regarding claim 20, the appellant argues that the Waller does not teach the system control unit performing at least one of the operations of cash dispensing, providing for cash settlement and monitoring maintenance information without needing authorization of user access from a remotely located network host computer.

In response to (G), firstly, the examiner upheld his 112 rejection stating that the limitation “without needing authorization of user access from a remotely located network host computer” was not clearly taught in the specification. The examiner would initially like to state that:

That a person skilled in the art might realize from reading the disclosure that such a step is possible is not a sufficient indication to that person that the step is part of appellants' invention. Such an indication is the least that is required for a description of the invention under the first paragraph of §112. See In re Smythe, 480 F.2d 1376, 178 USPQ 279

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(CCPA 1973). Claims added by amendment and drawn to an invention not so described in the specification are drawn to "new matter" and prohibited by §132. (See also for quote: In re Barker and Pehl, 194 USPQ 470 (CCPA 1977).)

The prevailing issue in this case appears to be regarding the addition by amendment of the negative claim limitations consisting of *not* needing authorization of user access from a remotely located network host computer. While there is no *in haec verba* requirement, newly added claim limitations must be supported in the specification through express, implicit, or inherent disclosure. The trouble is that there is no such disclosure, easy though it is to imagine it. *Purdue Pharma L.P. v. Faulding Inc.*, 230 F.3d 1320, 1328, 56 USPQ2d 1481, 1487 (Fed. Cir. 2000). The Examiner does not question whether the claim language is inconsistent with, or contradictory to, the teachings of the specification. But, the Examiner maintains that the specification does not **clearly and concisely** disclose to the skilled artisan that the inventors considered this particular authorization of user access claimed, *i.e.*, *not* needing authorization of user access from a remotely located network host computer, to be part of their originally filed invention. There is therefore no force to the applicants' or affiant's arguments that the written description requirement was satisfied because the disclosure revealed a broad invention from which the later-filed claims carved out a patentable portion.

Just b/c the spec COULD possibly support the narrow claim in a certain instance doesn't mean that at the time he wrote the spec he meant that specific instance now claimed.

This applies to the above limitation and the examiner reiterates that the specification doesn't require that the system control unit perform at least one of the

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operations of cash dispensing, providing for cash settlement and monitoring maintenance information **without needing authorization of user access from a remotely located network host computer.**

Even if the teachings required the above limitation, the authorization in the Waller reference only occurs in one embodiment on the invention. In paragraph [0018], the authorization occurs in a third embodiment of the invention. No authorization is needed in the first and second embodiments. In addition, while the act of cash dispensing may require authorization (paragraph [0021]), the act of monitoring maintenance information does not. The term "monitoring maintenance information" is not specifically detailed in the claims and therefore, can equate to receiving status information, which is shown in paragraph [0014] in the Waller reference. Once again, the examiner reiterates that:

Applicant's arguments fail to comply with 37 CFR 1.111(b) because they amount to a general allegation that the claims define a patentable invention without specifically pointing out how the language of the claims patentably distinguishes them from the references.

(H) Regarding claim 21, the appellant argues that the Waller reference does not teach the system control unit performing both of the operations of providing for cash settlement and monitoring maintenance information.

In response to (H), the examiner addressed that the Waller reference reads on the limitation of "providing for cash settlement" by pointing to paragraph [0021] as well as "monitoring maintenance information" in the response to (G) to show that the system

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control unit can perform both the above functions.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

Eugene Yun *EY*

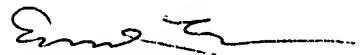
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